

Applicant : Michael J. Imperiale
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Attorney's Docket No.: 11203-002001 / UM 1750

REMARKS

This response is filed in reply to the Office Action mailed June 12, 2003. Claims 12, 15-16, 28-30, and 36-39 have been canceled. Claims 2, 6, 10, 13, 22, 27 and 42 have been amended. Claims 1, 3-5, 18, 20, 21, 23-25, 31-35, 40 and 41 are allowed. No new matter has been added. Claims 1-11, 13, 14, 17-27 31-35 and 40-42 are pending and at issue. Applicant requests reconsideration of the present application.

Claim Objections

Claims 6-8 are objected to because a nucleic acid allegedly does not produce a non-functional adenovirus protein. Claim 6 has been amended to delete "produce" and to recite "encode."

Claim 17 is objected to because a comma remains underlined from a previously filed amendment. The underline has been deleted.

Claim 22 is objected to because a nucleic acid allegedly does not produce a capsid protein. Claim 22 has been amended to delete "produce" and to recite "encode."

Claim 27 is objected to because the claim is allegedly in improper dependent format. Claim 27 has been amended to recite "the" vector system.

I. Rejections under 35 U.S.C. §112, First Paragraph

Written Description

Claims 9 and 42 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant traverses this rejection as it may apply to the amended claims.

Specifically, the Office Action alleges that the specification fails to provide a sufficient description of a genus of viral terminal repeats. Applicant notes that claim 42 has been amended

to recite an "adenovirus" terminal repeat. Accordingly, Applicant requests that the rejection under §112, first paragraph, be withdrawn.

II. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 2, 10, 11, 13, 14, 19 and 26-27 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant traverses the pending rejection.

The Office Action alleges that certain terms in claim 2 lack antecedent basis in claim 1. Claim 2 has been amended to delete "packaging" and "encoding sequences" and to recite:

"wherein the adenovirus capsid and 52/55 kDa protein are from human adenovirus and wherein the first and second adenovirus nucleic acid sequences are from human adenovirus"

The Office Action further alleges that there is insufficient antecedent basis for the recitation of "the failure to produce a functional trans-acting protein" as set forth in claims 10 and 11. Claim 10 has been amended to delete "produce" and to recite "encode".

The Office Action alleges that there is insufficient antecedent basis for the recitation of "the helper-dependent adenovirus on line 2 of claim 13. Applicants note that claim 13 was previously amended (see Preliminary Amendment filed March 25, 2003) to delete "helper-dependent" and to recite an "...adenovirus 52/55 kDa trans-acting protein that supports packaging of the first adenovirus nucleic acid sequence..." In addition, claim 13 is currently amended to recite a "...nucleic acid sequence functionally-associated with the genome of an adenovirus replication competent host cell containing the vector system."

The Office Action further alleges that there is insufficient antecedent basis for the recitation of "the helper adenovirus on line 11 of claim 19. Applicant notes that claim 19 was previously amended (see Preliminary Amendment filed March 25, 2003) to delete "helper" and to recite a "first adenovirus nucleic" and a "first adenovirus serotype 52/55 kDa trans-acting protein that supports packaging of the first adenovirus nucleic acid sequence..."

The Office Action further alleges that the word "means" is preceded by the word(s) "carrier" in an attempt to use a "means" clause to recite a claim element. Applicant notes that

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claim 27 was previously amended (see Preliminary Amendment filed March 25, 2003) to delete "carrier means being compartmentalized to receive in close confinement therein..."

In view of the amendments to the claims in the presently filed Amendment and the previously filed Preliminary Amendment, Applicant requests that the rejections under 35 U.S.C. §112, second paragraph, be withdrawn.

In summary, for the reasons set forth herein, Applicant maintains that claims 1-11, 13, 14, 17-27 31-35 and 40-42 clearly and patentably define the invention. Applicant respectfully requests that the Examiner reconsider the various grounds set forth in the Office Action, and allow all the claims that are now pending. If the Examiner would like to discuss any of the issues raised in this response, Applicant's representative can be reached at (858) 678-5070. Applicant asks that all claims be allowed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Michael Reed, Ph.D.
Reg. No. 45,647

Fish & Richardson P.C.
Customer Number: 20985
4350 La Jolla Village Drive, Suite 500
San Diego, California 92122
Telephone: (858) 678-5070
Facsimile: (858) 678-5099
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